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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|------------------------|---------------------------|------------------------|
| 09/682,314 | 08/17/2001 | James Kenneth Aragones | RD-28217 | 2332 |
| 41838 7590 01/07/2008 GENERAL ELECTRIC COMPANY (PCPI) C/O FLETCHER YODER P. O. BOX 692289 HOUSTON, TX 77269-2289 | | | EXAMINER CRAIG, DWIN M | |
| | | | ART UNIT 2123 | PAPER NUMBER |
| | | | MAIL DATE 01/07/2008 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/682,314

Applicant(s)

ARAGONES ET AL.

Examiner

Dwin M. Craig

Art Unit

2123

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22, 23, 25-28, 30, 31, 33-37, 39, 40, 42, 43, 45-47, 49-52, 54, 55, 57-61, 63, 64, 66, 67, 69-71, 73-76, 78, 79, 81-84, 86, 87 and 89-92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 22,23,25-28,30,31,33-37,39,40,42,43,45-47,49-52,54,55,57-61,63,64,66,67,69-71,73-76,78,79,81-84,86,87 and 89-92.

DETAILED ACTION

1. Claims 22, 23, 25-28, 30, 31, 33-37, 39, 40, 42, 43, 45-47, 49-52, 54, 55, 57-61, 63, 64, 66, 67, 69-71, 73-76, 78, 79, 81-84, 86, 87 and 89-92 have been presented for reconsideration based on Applicants' amended claim language and arguments.

Response to Arguments

2. Applicant's arguments, see Applicants' response page(s) 12-15, filed 10/18/2007, with respect to the previously applied 35 U.S.C. 101 and 35 U.S.C. 103(a) rejections of the claims have been fully considered and are persuasive. The rejections of claims 22, 23, 25-28, 30, 31, 33-37, 39, 40, 42, 43, 45-47, 49-52, 54, 55, 57-61, 63, 64, 66, 67, 69-71, 73-76, 78, 79, 81-84, 86, 87 and 89-92 has been withdrawn.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 22, 23, 25-28, 30, 31, 33-37, 39, 40, 42, 43, 45-47, 49-52, 54, 55, 57-61, 63, 64, 66, 67, 69-71, 73-76, 78, 79, 81-84, 86, 87 and 89-92 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-8, 10-36 of copending Application No. 10/707,655. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Taking claim 22 of the instant application and comparing said limitations to the limitations of claims 1 and 5 of U.S. Patent Application 10/707,655...

Claim 22 of the instant application discloses, *a method for performing engine baseline modeling...*

Claim 1 of 10/707,655 teaches, *a system for performing engine baseline modeling...*

Claim 22 of the instant application discloses, *storing the engine data...*

Claim 1 of 10/707,655 teaches, *an engine service database containing engine data...* this is performing *storage* of engine data...

Claim 22 of the instant application discloses, *preprocessing the engine data into a predetermined format, wherein the preprocessing comprises cleaning the engine data...*

Claim 1 of 10/707,655 teaches, *a preprocessor for processing the engine data into a predetermined format*, and claim 5, which depends from claim 1 teaches, *wherein the preprocessor comprises a data scrubbing component that cleans the engine data*.

Claim 22 of the instant application discloses, *building an engine baseline model for an engine from preprocessed data, wherein the engine baseline model relates engine performance variables as a function of engine operating conditions...*

Claim 1 of 10/707,655 teaches, *an engine baseline modeling component that builds an initial engine baseline model from the preprocessed data using a regression analysis, wherein the regression analysis relates engine performance variables as a function of engine operating conditions...*

Claim 22 of the instant application discloses, *evaluating the performance of the engine baseline model...*

Claim 1 of 10/707,655 teaches, *a model diagnostic component that evaluates the performance of the engine baseline model*.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 46, 47, 49-52, 54, 55, 57-61, 63, 64, 66, 67, 69, 86, 87 and 89-92 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Taking independent claims 46, 54, 60, 63, 64 and 86 as an example, all of these independent claims are for computer readable medium storing computer instructions, in paragraph [0037] of Applicants' specification is disclosed, "Note that the computer readable medium may comprise paper or another suitable medium upon which the instructions are printed...", Applicants' claimed *computer readable medium* could be interpreted to be non-functional descriptive material.

Non-function descriptive material is non-statutory subject matter, see section 2106.02 a portion of which is repeated here:

"Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and USPTO personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material. When a computer program is claimed in a process where the computer is executing the computer program's instructions, USPTO personnel should treat the claim as a process claim."

A piece of paper with the computer program being printed is not a *functional* computer readable medium as required by MPEP 2106.02 and is therefore the currently claimed computer readable medium could be interpreted, in view of the specification paragraph [0037] to be non-functional descriptive material.

Further regarding independent claims 46, 54, 60, 63, 64 and 86, these claims disclose a computer readable medium storing computer instructions, therefore this claimed medium is clearly for use in storing computer instructions and therefore excludes the *communication, propagation, transmission* and *transport* of instructions as described in sections [0036] and [0037] of the specification. Therefore, the claimed computer readable medium, as claimed, excludes the use of *infrared* transmission, transmission using, *one or more wires* and/or transmission upon an *optical fiber* as well as the use of *carrier waves*, because only the *storing* of the instructions is being claimed.

The Applicant is strongly encouraged to contact the Examiner regarding overcoming this rejection as set forth. The Examiner's contact information is provided at the conclusion of this Office Action.

Allowable Subject Matter

5. The indication of any allowable subject matter is being held in abeyance pending the resolution of the double patenting and 35 U.S.C. 101 rejections of the claims.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwin M. Craig whose telephone number is (571) 272-3710. The examiner can normally be reached on 10:00 - 6:00 M-F.

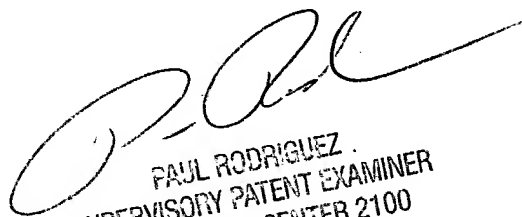
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul L. Rodriguez can be reached on (571) 272-3753. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Dwin McTaggart Craig
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PAUL RODRIGUEZ
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